

**REMARKS**

Claims 1-8, 18, and 19 are pending in this application, of which claim 1 is independent. Applicants acknowledge, with appreciation, the Examiner's indication that claim 7 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants submit that by the present Remarks, this application is placed in clear condition for immediate allowance.

**Information Disclosure Statement**

The Office Action acknowledges receipt of the Information Disclosure Statements filed June 12, 2007 and July 11, 2007. However, the copy of the PTO-1449 form for the June 12, 2007 IDS, attached to the present Office Action, does not indicate that the Examiner considered U.S. Patent Nos. 4,089,586 and 4,525,027. Applicants, therefore, respectfully request the Examiner to provide a appropriately initialed copy of the PTO-1449 form indicating consideration of U.S. Patent Nos. 4,089,586 and 4,525,027.

**Claim 1 has been rejected under 35 U.S.C. §112, second paragraph.**

The Examiner asserted that claim 1 is indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a question of law. *Zoltek Corp. v. United States*, 57 USPQ2d 1257 (Fed. Cir. 2000); *Personalized Media Communications LLC v. U.S. International Trade Commission*, 161 F.3d 696, 48 USPQ2d 1880 (Fed. Cir. 1998); *Tillotson Ltd. v. Walbro Corp.*, 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. § 112, the Examiner must provide a

basis and fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art, with the supporting specification in hand, would not be able to reasonably ascertain the scope or protection defined by a claim. *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976). Significantly, consistent judicial precedent holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Zoltek Corp. v. United States, supra*; *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *U.S. v. Teletronics Inc., supra*; *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ (Fed. Cir. 1986). Applicants stress that claims must be interpreted as one having ordinary skill in the art would have interpreted the claims in light of and consistent with the supporting specification. *Zoltek Corp. v. United States, supra*; *Miles Laboratories, Inc. v. Shandon, Inc., supra*.

Applicants submit that the Examiner did not discharge the initial burden of providing a basis in fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art would not be able to ascertain the scope of protection defined by the claims, when reasonably interpreted in light of and consistent with the supporting specification.

First, the Examiner asserted, “[t]he phrase ‘complying with the international standard of ITU-T G.652’ in claim 1 is a relative term which renders the claim indefinite.” Specifically, the Examiner asserted, “[t]he ITU-T G.652 standard has four distinct standards (G.652A, G.652B, G.652C and G.652D) and therefore citing G.652 is not clear as to what characteristics the limitation is referring to.”

In response, Applicants submit that it is well known among persons skilled in the art that the ITU-T G.652 standard includes four sub-categories A-D. The specification in paragraph [0010] describes, as follows:

The present invention has been accomplished in order to solve the problems as described above, and an object of the present invention is to provide an optical fiber excellent in compatibility with the standard single-board optical fiber defined by International Standard (ITU-T G.652) (capable of high-quality multiplexing transmission in the 1.3  $\mu$ m wavelength band), capable of high-quality multiplexing transmission in the 1.55  $\mu$ m wavelength band as well, and suitable for signal transmission in a wider band.

When persons skilled in the art read the above description of the specification, they will appreciate that the claimed optical fiber is compatible with the ITU-T G.652 including all four sub-categories A-D as a whole. There is no reason the standard claimed has to be one of sub-categories A-D. The ITU-T G.652 is well known among persons skilled in the art. It is, therefore, apparent that the Examiner did not provide any factual basis to support the ultimate legal conclusion that the persons skilled in the art would not be able to ascertain the scope of protection defined by the claims.

Second, the Examiner asserted, “industry standards may change over time, resulting as this limitation being indefinite” and “[a] claim may be rendered indefinite by reference to an object that these variable.” To support this argument, the Examiner mentioned *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989) and *Othokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Applicants submit that the Examiner’s position is unreasonable because if a standard is changed, i.e., a new standard is proposed, a different name is assigned to the new standard. Accordingly, the international standard of ITU-T G.652 is clear for persons skilled in the art. As set forth above, it is also apparent that the Examiner did not provide any factual basis to support the ultimate legal

conclusion that the persons skilled in the art would not be able to ascertain the scope of protection defined by the claims.

Based upon the foregoing, Applicants submit that the imposed rejection of claim 1 under the second paragraph of 35 U.S.C. §112 is not legally viable and, hence, respectfully solicit withdrawal thereof.

**Claims 1-6, 18, and 19 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bickham et al in view of Kato et al.**

In the statement of the rejection of the claims, the Examiner asserted that the applied combination of Bickham et al. and Kato et al. teaches the claimed subject matter. Applicants respectfully traverse.

Applicants submit that Bickham et al. and Kato et al., either individually or in combination, do not disclose or suggest an optical fiber including all the limitations recited in independent claim 1. Specifically, the applied combination does not teach, at a minimum, an optical fiber which complies with the International Standard of ITU-T G.652, as recited in claim 1.

The Examiner asserted, “since it is not known what ITU-T G.652 standard the applicant is referring to, the office cannot determine what characteristics this limitation refers to” and “[s]ince the claim does not state any actual standard limits and just states a broad standard, this limitation cannot be considered” (the paragraph bridging pages 5 and 6 of the Office Action). In this respect, Applicants already explained that the limitation regarding the International Standard of ITU-T G.652 is definite for persons skilled in the art, and traversed the rejection of claim 1

under 35 U.S.C. §112, second paragraph. The Examiner is required to give patentable weight to the limitation regarding the ITU-T G.652.

As discussed in the September 13, 2007, Bickham et al. teaches a DFF (Dispersion Flattered Fiber), and Kato et al. teaches a NZDSF (Non-Zero Dispersion Shifted Fiber). It should be apparent that the optical fibers of Bickham et al. and Kato et al. are different from the claimed optical fiber in terms of their compliance with the International Standard of ITU-T G.652, directed to a standard single Board optical fiber. The rejection is not legally viable for at least this reason.

Based on the above, Applicants submit Bickham et al. and Kato et al., either individually or in combination, do not disclose or suggest an optical fiber including all the limitations recited in amended independent claim 1. Dependent claims 2-6, 18, and 19 are also patentably distinguishable over Bickham et al. and Kato et al., at least because these claims respectively include all the limitations recited in claim 1. Applicants, therefore, respectfully solicit withdrawal of the rejection of the claims and favorable consideration thereof.

**Claim 8 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Bickham in view of Kato et al., and further in view of Sasaoka et al.**

Claim 8 depends from independent claim 1. Applicants, thus, incorporate herein the arguments made to respond to the rejection of independent claim 1 under 35 U.S.C. § 103 for obviousness predicated upon Bickham et al. and Kato et al. The Examiner's additional comments and reference to Sasaoka et al. do not cure the previously argued deficiencies of the applied combination of Bickham et al. and Kato et al. Applicants, therefore, respectfully solicit withdrawal of the rejection of claim 8 and favorable consolation thereof.

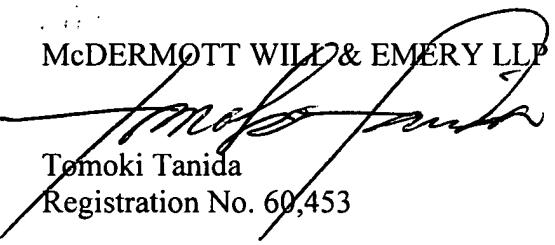
**Conclusion**

It should, therefore, be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL& EMERY LLP

  
Tomoki Tanida  
Registration No. 60,453

**Please recognize our Customer No. 20277  
as our correspondence address.**

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 BKS:TT  
Facsimile: 202.756.8087  
**Date: January 4, 2008**

WDC99 1508262-1.050212.0631